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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,141	03/19/2001	Hubertus V. Thomeer	56.0546CIP	1045

7590 08/19/2003
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EXAMINER

WONG, ALBERT KANG

ART UNIT PAPER NUMBER

2635

DATE MAILED: 08/19/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

12

Office Action Summary

Application No.

09/812,141

Applicant(s)

THOMEER ET AL.

Examiner

Albert K Wong

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5-9, 11
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. This Office action is in response to the application filed March 19, 2001. This application is a CIP of Claims 1-27 are pending. The effective filing date for the claimed subject matter has been determined to be March 19, 2001. If applicant asserts the benefit of an earlier filing date, he should specifically point out sections in the parent application which support the claimed invention. The IDSs filed 8/12/2002, 12/16/2002, 1/30/2003, 4/8/2003, 4/14/2003, 8/4/2003, and 8/12/2003 are acknowledged. Initialed copies are attached.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4 and 14-18, drawn to a method for controlling downhole equipment, classified in class 340, subclass 855.3.
- II. Claims 5-8, drawn to a method for orienting downhole equipment, classified in class 166, subclass 255.1.
- III. Claims 9-13 and 19-23, drawn to a method for transmitting telemetry data, classified in class 340, subclass 853.1.
- IV. Claims 24-27, drawn to a method of communicating between downhole tools in a well, classified in class 340, subclass 853.7.

3. Inventions I-IV are distinct from each other if they are shown to be separately usable. In the instant case, inventions II-IV have separate utility such as a method for orienting equipment, a method for sending telemetry data, a method for communicating between different downhole equipment, and a method for communicating between tools. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and the search required for each Group is not required for remaining Groups, restriction for examination purposes as indicated is proper.

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Tubel '547. The cited passages should not be construed as the only teaching of the claimed steps.

Regarding claim 24, Figure 6 shows a downhole structure (item 22) with one non-acoustic transmitter unit and one receiver unit (item 52). Figure 9 shows a second unit that functions is connected to the first unit where both units have non-acoustic transmitters and receivers (items 22). The receivers of each unit receive signals transmitted by the transmitter of another unit as taught in col. 15, lines 30-32. Also see col. 9, lines 42-46.

Regarding claim 25, see col. 11, lines 25-30.

Regarding claim 26, see col. 11, lines 45-50.

Regarding claim 27, Figure 6 shows a non-acoustic receiver unit with storage capacity for storing a received signal.

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7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The other cited Tubel references also teach downhole communication systems with transceivers.

8. During a telephone conversation with Wayne Kanak on August 13, 2003 a provisional election was made without traverse to prosecute the invention of Group x, claims 24-27.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert K Wong whose telephone number is 703-305-8884. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

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A handwritten signature in black ink, appearing to read 'Albert K. Wong', written in a cursive style.

Albert K. Wong
August 14, 2003